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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,360	03/18/2004	James Kevin Gillic	A1019-20354	5836
3000	7590	11/30/2005	EXAMINER	
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			TRAN, THAO T	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/803,360

Applicant(s)

GILLIE, JAMES KEVIN

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 25-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to the Amendments filed on 9/16/2005.
2. Claims 1-48 are currently pending in this application. Claim 1 has been amended in this Reply. Claims 25-48 have been withdrawn from consideration pursuant to a restriction requirement.
3. In view of the prior Office action, the rejection of claims 1-6, 8, 11-17, 21-24 as being anticipated by Kinoshita et al. (US Pat. 5,824,394), has been withdrawn due to the Amendments made thereto.
4. In view of the prior Office action, the rejection of claims 7, 9-10, 12, 18-20 as being unpatentable over Kinoshita, has been withdrawn due to the Amendments made thereto.
5. A new rejection is issued as follows.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. (US Pat. 5,824,394) in view of Posey et al. (US Pat. 4,525,419).

Kinoshita teaches a printable laminate, comprising a polyester film comprising polypropylene (in layer B) and a coating comprising urethane-based resin (see abstract; col. 2, ln.

33-43; col. 9, ln. 28-35; Example 6). The urethane-based resin is water soluble, containing an acrylic-based polyol and a crosslinking agent, such as aziridine, and an antiblock agent (see col. 7, ln. 7-17, 33; col. 8, ln. 24-35). The polyester film may be surface treated with chemical or discharge (oxidative) treatment before coating (see col. 9, ln. 62-67). The polyester film further comprises an antiblock agent (slip agent) such as silica in an amount of 0.1% (see col. 15, ln. 34-37).

Moreover, it is hereby noted that although Kinoshita teaches the same steps of stretching of the film as presently claimed, it is the structural elements that impart patentability to an article claim, and not how the layers are made.

In regards to claims 1-6, 8, 11-17, and 21-24, Kinoshita differs from the presently claimed invention because the reference does not teach the base film to be predominantly polypropylene.

Posey discloses a printable laminate, wherein the base film is an oriented plastic film made of polyester or polypropylene (see col. 3, ln. 25-30). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the polypropylene film, as taught by Posey, as the base film in Kinoshita. By teaching polypropylene as an equivalent of polyester base film, Posey directly teaches that the use of one in substitute for another would have yielded the same results.

In regards to claim 7, Kinoshita teaches that the coating layer contains acrylic-based resin or urethane-based resin (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine these two resins because it has been held obvious that combining two compositions each of which is taught by the prior art to be

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useful for the same purpose, in order to form a third composition to be used for the very same purpose. See MPEP 2144.06.

In regards to claims 9-10, 12, although Kinoshita does not specify the amount of the antiblock agent or the crosslinking agent in the coating layer, since Kinoshita teaches that the amount of the antiblock agent or the crosslinking agent in the polyester film is 0.1%, it would have been obvious that the amounts of these agent in the coating layer would be the same as that in the polyester film, in order to have the layers more compatible with each other in terms of crosslinking and/or antiblocking. Moreover, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the concentration of a compound would have been determined by routine experimentation in order to achieve the desired results, such as crosslinking and/or antiblocking.

In regards to claims 18-20, although Kinoshita does not specifically teach the polypropylene to be a homopolymer, copolymer, or a combination thereof, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the polypropylene would have been one of these three possibilities, and the use of them would have given the same results since they are alternative of each other as disclosed in the present specification. Moreover, it has been within the skill in the art that the selection of a known material based on its suitability for its intended use would have been obviousness determination. See MPEP 2144.06, 2144.07.

*Response to Arguments*

8. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

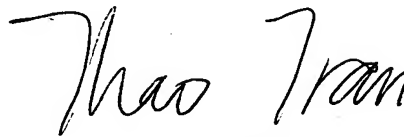
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt  
November 23, 2005



**THAO T. TRAN**  
**PATENT EXAMINER**